Paper No. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHALONG MAA

Appeal No. 2001-0908
Application No. 08/833,342

ON BRIEF

Before THOMAS, LALL, and DIXON, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 35-60, which constitute all of the pending claims in the application.

According to appellant (specification at page 2 and 3), the invention is directed to a low cost talking figure toy which can be used as an early age educational tool. The figure toy need not be sold with predefined phrases or complex circuitry. The toy users can create or edit speech phrases and body movement of the toy using standard text editors by the selection of prerecorded audio files

on their personal computers. By utilizing preexisting personal computers, the toy's manufacturing costs are kept low, yet the toy's activities are enhanced with programmability. The figure toy of this invention is provided with a relatively simple, two phase actuator for each of its moving body parts. The actuator does not require a gear system and can be controlled with a simple, binary digital code from a personal computer. The actuator is relatively simple and inexpensive, allowing the toy to be manufactured at a cost substantially less than many other prior art animated talking figure toys. The two-phase drive device, controlled with a digital signal, thus enables a home computer to control animation of figure toys and dolls with a relatively low manufacturing costs.

A further illustration of the invention can be obtained from the following claim.

35. In combination with a multimedia computer, an animated talking toy including a body portion having at least one movable portion and a loudspeaker situated within said body for reproducing selected audio sound in response to receiving an external sound signal transmitted from the multimedia computer, the improvement therein including actuation means situated within said body and operable by an external digital animation-control signal transmitted from the multimedia computer, said actuation means including:

an actuator for moving said movable portion; and

actuation-control means for controlling the actuator;

said actuator having only two phases for moving said movable portion in response to said actuation-control means receiving said external digital animation-control signal.

The examiner relies on the following references:

Gasper et al. (Gasper)	5,111,409	May 5, 1992
Tong	5,636,994	Jun. 10, 1997 (filed Nov. 9, 1995)

Claims 35, 37 and 43 stand rejected under 35 U.S.C. § 102 as being anticipated by Tong.

Claims 36 and 38-42 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tong.

Claims 44-60 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tong of view of Gasper.

Rather than repeat the arguments of appellant and the examiner, we make reference to the brief (paper no. 31) and the examiner's answer (paper no. 34) for the respective details thereof.

OPINION

We have considered the rejections advanced by the examiner and the supporting arguments. We have, likewise, reviewed the appellant's arguments set forth in the brief.

We reverse.

At the outset, we note that the claims on appeal are rejected under 35 U.S.C. § 102 and § 103. We consider these rejections separately below:

Rejection under 35 U.S.C. § 102[1]

The examiner rejects claims 35, 37 and 43 under this heading at page 5 of the examiner's answer as being anticipated by Tong. The examiner points to Figure 6 of Tong and asserts that

> while the information within the signal is analog data, the dolls activators [27 and 28] respond to the presence or lack of the signal, taking not the audio data within, but the presence of the signals itself as a logical signal.

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[1]Of the issues listed at page 3 of the brief, only the rejection under 35 U.S.C. § 102(e) and § 103(a) are remaining on appeal as listed by the examiner at page 5 of the examiner's answer. Therefore, we discuss here only the rejections under these two grounds of rejections.

Appellant argues (brief at page 17) that

> In contrast thereto, TONG discloses the combination of a doll and a multimedia computer wherein the doll receives the same analog sound signal from the computer for controlling all the drive motors within the doll as well as for supporting the doll's audio output . . . . As it is well known, an analog sound signal sequence has a continuous and alternating voltage level. TONG fails to disclose an animated toy figure of the type feasible for digital control.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently, See Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

By applying the above test of anticipation, we are not persuaded by the examiner's assertion that the analog signal in Tong can be considered a digital signal because it is a logical signal. As pointed out by appellant, the motors 27 and 28 in Tong are analog actuators and are capable of being responsive to only analog signals present at conductors 32 in Figure 6.

The examiner makes a correspondence table at page 9 of the examiner's answer showing the correspondence of the claim elements in each of these claims to the disclosure in Tong. However, we are of the opinion that the examiner has not grappled with the issue of the recited digital signal operating a two phase actuator in the claimed toy computer. Therefore, we do not sustain the anticipation rejection of claims 35, 37 and 43 by Tong.

Rejections under 35 U.S.C § 103

As a general proposition, in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness, is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Following the guidelines of a rejection under this ground of rejection, the examiner sets forth a rejection of claims 36 and 38-42 at page 6 of the examiner's answer, wherein the examiner asserts that

> Applicant is given Official Notice that the use of solenoids as actuators for the movement of dolls and figures is well known in the art and it would have been obvious . . . to connect two-phase solenoids as the actuators in the invention of Tong in order to reduce the complexity and cost of the actuators and the invention.

Appellant argues (brief at page 14 and 15) that each of these claims recites an actuator having only two phases and an actuation-controlled means operable by a digital signal, which are not taught nor suggested by Tong. Appellant further argues (brief at page 19) that

> In contrast thereto, TONG employs conventional *rotary* D.C. motors for actuating the movable portions of the doll. TONG does not teach or suggest employing an actuation device of the type having two (2) operation phases concurrent with the

> digital binary codes "1" and "0", and fails to disclose an animated talking toy of the type having binary actuation arrangement feasible for digital operation and control.

The examiner responds (answer at page 12) by reiterating the position stated in the final rejection.

We do not agree with the examiner's position. The Tong reference merely discloses a toy figure which has two analog motors 27 and 28 in Figure 6, and these analog motors respond to an analog signal being transmitted by computer 11 to accomplish the movement of various parts of the toys. There is no digital signal being directly sent to the toy, and neither is the toy operable by a digital signal. Rather, the toy requires the incoming signal to be of analog nature. The examiner's position that the analog motors 27 and 28 are somehow equivalent to the two-phase actuators recited in claims 36 or 38 or 42 and disclosed in Figure 3A and 3B of the disclosure is not justifiable. Therefore, we do not sustain the obviousness rejection of claims 36, 38-42 over Tong.

Tong and Gasper

The examiner combines the teaching of Gasper to the teachings of Tong to reject claims 44-60 at page 6 of the examiner's answer. The examiner uses Gasper for the teaching of sound-synchronized animation for use in a game and asserts that Gasper teaches the proper lip synchronization of an inputted word. However, we agree with the appellant that Gasper does not cure the deficiency of Tong noted above. Therefore, we do not sustain the obviousness rejection of claims 44-60 over Tong and Gasper.

The decision of the examiner rejecting claim 35-60 is reversed

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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PARSHOTAM S. LALL) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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